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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,051

01/09/2007

Jurgen Dietz

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EXAMINER

BEAUCHAINE, MARK J

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,051	<b>Applicant(s)</b> DIETZ ET AL.	
	<b>Examiner</b> MARK J. BEAUCHAINE	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 81 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claim claims both an apparatus and a method for using said apparatus. Specifically, said claim recites both a system comprising a banknote processing machine and a service center, and a method of operating said system. Since said claim claims both an apparatus and a process it is indefinite. (See M.P.E.P. 2173.05(p).)

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 81 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, said claim is directed to neither a “process” nor a “machine,” but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which sets forth the statutory classed in the alternative only. (See M.P.E.P. 2173.05(p).) Specifically, said claim recites both a

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“machine” (*i.e.*, a system comprising a banknote processing machine and a service center), and a process (*i.e.*, a method for operating said system).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10, 24-29, 31-38, 40-50, 58, 61-66, 68, 69 and 71-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Application Publication Number US 2002/0035541 A1 by Makino et al (“Makino”) in view of Patent Number 5,847,658 by Irie et al. (“Irie”). The banknote processing machine system disclosed by Makino comprises banknote processing machines 3a-3n that are connected to service center 2 via network Dnet (see Figure 1) which comprises the Internet (see paragraph 0066). Machine

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operation software preset data are exchanged from said service center to said machine and replace data in said banknote processing machine via said network using a standard protocol to adjust and control said machines (see paragraphs 0062, 0063 and 0082-0091).

Makino further discloses said banknote processing machines being connected to one another and data being exchanged between said machines (see paragraph 0107), monitoring unit 4 that has an operator assigned to monitor said machines (see paragraph 0068), and machine data being stored in data memory DB of said service center 2 which evaluates said data (see paragraph 0098). Still further, said machines send fault reports/log files to said service center and are displayed via an input/output device (see paragraph 0138), banknote machine data is backed-up prior to an exchange of data to said machine (see paragraphs 0004 and 0157), and fundamental parts of machine data V-Rom (see Figure 2) cannot be altered by exchange data. Said system further discloses an alarm message that is generated as a result of exchange data and is sent to a processing machine (see paragraph 0138, lines 22-30), and machine files (see paragraph 0067).

Makino fails to disclose said log files being evaluated for increasing deviations and to effect machine repairs prior to failure. Iris teaches a machine system comprising machine 1 being monitored such that log files regarding increasing irregularities of said machine are maintained and evaluated to cause repairs to be carried out prior to failure (see Figures 1 and 11; column 1, lines 6-43; column 5, lines 12-31; and column 17, lines 5-14) for the purpose of reducing the cost and time associated with non-operating

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equipment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the file evaluation configuration of Irie into the network of Makino for the purpose of reducing the cost and time associated with non-operation of said machines.

Claims 11-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makino in view of Irie as applied to claim 1 above, and further in view of Patent Application Publication Number US 2002/0046061 A1 by Wright et al ("Wright"). Makino/Irie fails to disclose departments being connected to said service center. Wright teaches a communication network comprising departments 326A-326D that are connected to and are in data communication with service department 120 that is operated by a service person (see Figure 3 and paragraph 0054) for the purpose of transmitting specific data to and from said service center. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the department/service center configuration of Wright into the system of Makino/Irie for the purpose of transmitting specific data to and from said service center.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makino in view of Irie as applied to claim 1 above, and further in view of Patent Number US 6,508,398 B1 by Estes ("Estes"). Makino/Irie fails to disclose a further network-connected service center. Estes teaches a banknote processing machine system comprising service center 30 and further service center 68 that are in communication

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with banknote processing machine 36 (see sole figure, column 2, lines 11-24, and column 3, lines 5-19) for the purpose of enhancing data transfer to and from said banknote machine. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the further service center of Estes into the system of Makino/Irie for the purpose of enhancing data transfer to and from said banknote machine.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makino in view of Irie as applied to claim 1 above, and further in view of Patent Number US 7,092,907 B2 by Kanevsky et al ("Kanevsky"). Makino/Irie fails to disclose a trial version of transferred data. Kanevsky teaches a data transfer system having including a trial version of data for a processing machine that is transferred from a service center (see column 1, lines 51-56 and column 2, lines 30-39) for the purpose of determining the effectiveness of said data in the operation of said system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the trial version of data of Kanevsky into the system of Makino/Irie for the purpose of determining the effectiveness of said data in the operation of said system.

Claims 30, 53-57 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makino in view of Irie as applied to claim 1 above, and further in view of Patent Number US 6,430,470 B1 by Nakajima et al ("Nakajima"). Makino/Irie fails to disclose the charging of a data transmission fee. Nakajima teaches a banknote

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processing machine network system that operates to charge a fee for data transmitted to banknote processing machines (see column 4, lines 28-38) for the purpose of generating revenue for the system operator. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the transmission fee charge of Nakajima into the system of Makino/Irie for the purpose of generating revenue for the system operator.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makino in view of Irie as applied to claim 38 above, and further in view of Patent Application Publication Number US 2004/0164141 A1 by Egami et al ("Egami"). Makino/Irie fails to disclose the monitoring of a person. Egami teaches a banknote processing machine that monitors the presence of a person via camera 6 (see Figures 1A and 2A and paragraph 0035) for the purpose of verifying the identity of persons operating said machine. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the monitoring operation of Egami into the banknote machine of Makino/Irie for the purpose of verifying the identity of persons operating said machines.

Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makino in view of Irie as applied to claim 1 above, and further in view of Patent Number US 7,395,241 B1 by Cook et al ("Cook"). Makino/Irie fails to disclose an authorized source check. Cook teaches a banknote data transfer system that is arranged to check whether data to be exchanged originate from an authorized source



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(see column 8, lines 29-50) for the purpose of providing secure monetary data transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the authorized source check of Cook into the system of Makino/Irie for the purpose of providing secure monetary data transactions.

Claims 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makino in view of Irie as applied to claim 58 above, and further in view of Patent Number US 6,363,164 B1 by Jones et al ("Jones"). Makino/Irie fails to disclose banknote comparison data. Jones teaches a banknote system comprising processing machines that generate banknote data via service center 930 (see Figure 4a and column 20, lines 48-67) for the purpose of determining the authenticity of banknotes processed by said machine. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the comparison data of Jones into the system of Makino/Irie for the purpose of authenticating banknotes processed by said machine.

Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makino in view of Irie as applied to claim 69 above, and further in view of Patent Application Publication Number US 2008/0243915 A1 by Shah et al ("Shah"). Makino/Irie fails to disclose a replacement part request. Shah teaches a stationary apparatus monitoring network (see paragraphs 0010, 0079 and 0084) that operates to request an operator to deliver replacement parts (see paragraphs 0040, 0070, 0072, 0073 and 0076) for the

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purpose of permitting the repair of articles associated with said network in a timely manner. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the replacement part request of Shah into the system of Makino/Irie for the purpose of permitting the repair of articles associated with said system in a timely manner.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-81 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK J. BEAUCHAINE whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stefanos Karmis can be reached on (571)272-6744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark J. Beauchaine/  
Examiner, Art Unit 3653

mjb